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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,458	04/03/2001	Venkata Katikaneni	F-113	8314
919 7590 09/19/2007 PITNEY BOWES INC. 35 WATERVIEW DRIVE P.O. BOX 3000 MSC 26-22 SHELTON, CT 06484-8000			EXAMINER WU, RUTAO	
			ART UNIT 3628	PAPER NUMBER
			MAIL DATE 09/19/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/973,458

**Applicant(s)**

KATIKANENI ET AL.

**Examiner**

Rob Wu

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-20,22-24,28-33 and 35-37 is/are allowed.
- 6) ☒ Claim(s) 13-15,21,25-27 and 34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. In view of the Appeal Brief filed on June 04 2007, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

  
JOHN W. HAYES  
SUPERVISORY PATENT EXAMINER

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 13 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat No. 6,234,694 to Brookner.

**Referring to claim 13:**

A postage printing system, comprising:

A registration wall; (Fig 2A)

A transport device for feeding an envelope having a plurality of lateral edges in a path of travel through the postage printing system where one of the plurality of lateral edges is aligned with the registration wall; (col 4: lines 11-13; Fig 2A)

A printer capable of printing a postal indicia and an ad slogan on the envelope, the printer being located in proximity to the path of travel so as to define a print position; (col 3: lines 21-27)

A control system in operative communication with the transport device and the printer, the control system for:

Obtaining an indication from an operator of a selected print location for the ad slogan; (col 3: lines 21-25; col 4: lines 45-47; Fig 1) and

Brookner discloses determining if the postal indicia and the ad slogan may be printed in a single physical pass of the envelope through the print position of the path of

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travel postage printing system by providing several embodiments where if the print contents cannot be properly printed in one physical pass, adjustments are then made to the ad images to allow a single physical pass.

**Referring to claim 25:**

A method of operating a postage printing system, the method comprising:

Feeding an envelope having a plurality of lateral edges in a path of travel through the postage printing system and along a registration wall where one of the plurality of lateral edges is aligned with the registration wall; (col 4: lines 11-13; Fig 2A)

Defining a print position where a postal indicia and an ad slogan may be printed on the envelope (col 3: lines 21-25);

Obtaining an indication from an operator of a selected print location for the ad slogan; (col 3: lines 21-25; col 4: lines 45-47; Fig 1) and

Brookner discloses determining if the postal indicia and the ad slogan may be printed in a single physical pass of the envelope through the print position of the path of travel postage printing system by providing several embodiments where if the print contents cannot be properly printed in one physical pass, adjustments are then made to the ad images to allow a single physical pass.

4. Claims 14, 15, 21, 26, 27 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brookner and further in view of U.S. Pat No. 6,389,327 to Thiel.

**Referring to claim 14:**

Brookner does not expressly disclose if the control system determines that the postal indicia and the ad slogan cannot be printed in a single pass through the postage printing system, then the postal indicia is printed in one pass through the postage printing system and the ad slogan is printed in another pass through the postage printing system.

Thiel disclose two physical passes of a mail piece wherein one pass is to print the addressing data on the mail piece and the second pass is to print the franking data on the mail piece. (Fig 1; col 3: lines 40-46)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Brookner to attempt printing the ad slogan and postage indicia in two different physical passes instead of altering the ad slogan images to print both one physical pass. Brookner would be motivated to attempt two physical passes to ensure that the operators and customers are satisfied with ad slogan on the mail piece.

**Referring to claim 15:**

The postage printing system of claim 14, wherein:

Brookner discloses before the another pass through the postage printing system, the control system provides the operator with an indication of an anticipated orientation of feeding the envelope through the postage printing system based upon the selected print location. (col 4: lines 2-20)

**Referring to claim 21:**

A postage printing system, comprising:

Brookner discloses the following

A registration wall; (Fig 2A)

A transport device for feeding an envelope having a plurality of lateral edges in a path of travel through the postage printing system where one of the plurality of lateral edges is aligned with the registration wall; (col 4: lines 11-13; Fig 2A)

A printer capable of printing a postal indicia and an ad slogan on the envelope, the printer being located in proximity to the path of travel so as to define a print position; (col 3: lines 21-27)

A control system in operative communication with the transport device and the printer, the control system for:

Brookner does not expressly disclose causing the postal indicia to be printed in one physical pass through the path of travel of the postage printing system and the ad slogan to be printed in another physical pass through the path of travel of the postage printing system;

Thiel disclose two physical passes of a mail piece wherein one pass is to print the addressing data on the mail piece and the second pass is to print the franking data on the mail piece. (Fig 1; col 3: lines 40-46)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Brookner to attempt printing the ad slogan and postage indicia in two different physical passes instead of altering the ad slogan images to print both one physical pass. Brookner would be motivated to attempt two physical

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passes to ensure that the operators and customers are satisfied with ad slogan on the mail piece.

and

Brookner disclose before the another physical pass through the path of travel of the postage printing system, providing the operator with an indication of an anticipated orientation of feeding the envelope through the postage printing system based upon a selected print location. (col 4: lines 2-20)

**Referring to claim 26:**

Brookner does not expressly disclose if the postal indicia and the ad slogan cannot be printed in a single pass through the postage printing system, then the postal indicia is printed in one pass through the postage printing system and the ad slogan is printed in another pass through the postage printing system.

Thiel disclose two physical passes of a mail piece wherein one pass is to print the addressing data on the mail piece and the second pass is to print the franking data on the mail piece. (Fig 1; col 3: lines 40-46)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Brookner to attempt printing the ad slogan and postage indicia in two different physical passes instead of altering the ad slogan images to print both one physical pass. Brookner would be motivated to attempt two physical passes to ensure that the operators and customers are satisfied with ad slogan on the mail piece.

**Referring to claim 27:**



The postage printing system of claim 26, wherein:

Brookner discloses before the another pass through the postage printing system, the control system provides the operator with an indication of an anticipated orientation of feeding the envelope through the postage printing system based upon the selected print location. (col 4: lines 2-20)

**Referring to claim 34:**

A method of operating a postage printing system, the method comprising the step(s) of:

Feeding an envelope having a plurality of lateral edges in a path of travel through the postage printing system and along a registration wall where one of the plurality of lateral edges is aligned with the registration wall; (col 4: lines 11-13; Fig 2A)

Defining a print position where a postal indicia and an ad slogan may be printed on the envelope (col 3: lines 21-25);

Brookner does not expressly disclose causing the postal indicia to be printed in one physical pass through the path of travel of the postage printing system and the ad slogan to be printed in another physical pass through the path of travel of the postage printing system;

Thiel disclose two physical passes of a mail piece wherein one pass is to print the addressing data on the mail piece and the second pass is to print the franking data on the mail piece. (Fig 1; col 3: lines 40-46)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Brookner to attempt printing the ad slogan and

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postage indicia in two different physical passes instead of altering the ad slogan images to print both one physical pass. Brookner would be motivated to attempt two physical passes to ensure that the operators and customers are satisfied with ad slogan on the mail piece.

and

Brookner disclose before the another physical pass through the path of travel of the postage printing system, providing the operator with an indication of an anticipated orientation of feeding the envelope through the postage printing system based upon a selected print location. (col 4: lines 2-20)

***Allowable Subject Matter***

5. Claims 16-20 are allowed over prior art.
6. Claims 22-24, 28-33 and 35-37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is an examiner's statement of reasons for allowance:

The closest prior art of record is U.S. Pat No. 6,234,694 to Brookner and U.S. Pat No. 6,389,327 to Thiel.

Brookner discloses a postage and ad printing system that is capable of printing an ad slogan on a operator defined area on an envelope with the postage indicia and determines whether it can properly be printed.

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Thiel discloses a postage printing system where the addressing information and the franking information are printed through two different physical passes.

As per claim 16 and 22, 28, and 35 the closest prior art of record fails to teach or suggest using a scanner to detect distinguishing characteristic of the envelope to decide an orientation of the envelope for printing an ad slogan. Claims 17-20 depends on claim 16 and thus are allowable for the same reason.

### ***Conclusion***

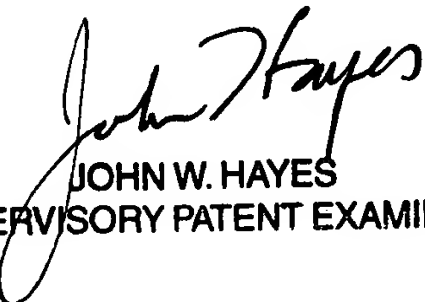
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Wu whose telephone number is (571)272-3136. The examiner can normally be reached on Mon-Fri 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571)272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

rw

  
JOHN W. HAYES  
SUPERVISORY PATENT EXAMINER